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| 09/878,214 | 06/12/2001 | Jeffrey H. Diamond | 0136.0004C | 4957 |

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| EXAMINER |
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GLESSNER, BRIAN E

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| ART UNIT | PAPER NUMBER |
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3635

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,214

Applicant(s)

DIAMOND, JEFFREY H.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 17-19 and 29-43 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 16 and 20-27 is/are rejected.
- 7) ☒ Claim(s) 9-15 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following office action is in response to the RCE and amendment filed on December 19, 2003. Claims 1-43 are pending in the application.

Claim Objections

1. Claim 22 is objected to because of the following informalities: Claim 22, line 3 has been amended to change the term "cavity" to "interior". The term "interior" was not mentioned in claim 1. Therefore, it appears that the term "cavity" would have antecedent basis and would make the claim clearer. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 6 and 16, the scope of the claim is unclear because the examiner is not certain if the applicant wants to claim a combination or a subcombination. Claims 1 and 2 are both claiming the subcombination of a compressible structure. However, claims 6 and 16 claim that the securing element is interposed between the perimeter and the window structure, and that the front wall is spaced from the glass pane and the cavity is defined between said front wall and said glass pane. These phrases positively claim the window. Therefore, claims 6 and 16 appear to be combination claims and will be examined as such. If the applicant wants to claim the combination, the independent claims need to be amended to make this clear.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8, and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessler (4,098,035).

In regard to claims 1 and 2, Bessler discloses a compressible structure capable of temporarily protecting a glass pane of a window structure comprising a shaping member 14 and a fluidic material 72, column 4, lines 31-34. Said shaping member is capable of being removably secured to a window structure and defining a cavity over the glass pane, and the fluidic material is also capable of solidifying within said cavity into a body of compressible material, which will provide protection for the glass pane. When installed, the cavity would be defined by the sidewalls of the member 14 and the solidified compressible material is shown in figure 7. The examiner would like to point out that the only elements the applicant is positively claiming are the shaping member and the fluidic material. Therefore, since Bessler discloses all of the structural features of the claim, his device is inherently capable of performing the same functions as applicant's claimed device. Bessler further discloses the use of a port 40 in the shaping member communicating with said cavity by which said compressible material is supplied to said cavity in fluidic form and then, solidifies within said cavity.

In regard to claim 3, Bessler discloses the claimed invention, wherein the compressible material is a polymeric foam, i.e. plastic, column 4, lines 31-34.

In regard to claim 4, Bessler discloses the claimed invention, wherein the structure further comprises a securing element 62 capable of removably securing said compressible structure on the window structure.

In regard to claim 5, Bessler discloses the claimed invention, wherein said securing elements includes a releasable adhesive carried by said shaping member.

In regard to claim 6, Bessler discloses the claimed invention, wherein said compressible structure has an external perimeter and said securing element includes one or more securing devices that are positioned on the perimeter and are adapted to be placed between the perimeter and the window structure.

In regard to claim 8, Bessler discloses the claimed invention, wherein said shaping member includes a front wall, a back wall capable of being disposed adjacent to the glass pane and one or more side walls connecting said front and back walls, said cavity being defined between said front and back walls, figures 5 and 7. Figure 5 clearly shows the different sides of the shaping member.

In regard to claim 22, Bessler disclose the claimed invention, wherein said shaping member is adjustable in external size in response to a variation in the amount of said fluidic material introduced in said cavity, column 1, lines 65-68 and column 2, lines 1-3.

In regard to claim 23, Bessler discloses a window protection system capable of temporarily protecting a glass pane comprising a shaping member 14 capable of being removably secured on a window structure and defining a cavity over the glass pane (the cavity is defined by the hollow interior of the member 14), a port 40 in said shaping member establishing communication with said cavity from externally of said shaping member, and a supply system

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including a quantity of compressible material 72 in fluid form and a delivery device (not shown, column 3, lines 29-30) for supplying said compressible material in fluid form through said port and into said cavity, said compressible material in fluid form solidifying within said cavity to form a layer of solidified compressible material, thereby forming a compressible structure, defined by said shaping member and said layer of solidified compressible material, over the glass pane capable of providing protection thereto.

In regard to claim 24, Bessler discloses the claimed invention, wherein the compressible material is a polymeric foam, i.e. plastic, column 4, lines 31-34.

In regard to claim 25, Bessler discloses the claimed invention, wherein the structure further comprises a securing element 62 capable of removably securing said compressible structure on the window structure.

In regard to claim 26, Bessler discloses the claimed invention, wherein said securing element includes an adhesive.

In regard to claim 27, Bessler discloses the claimed invention, wherein said securing element includes one or more mechanical securing devices. The examiner would like to point out that the adhesive strip is a mechanical device as well.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessler (4,098,035).

In regard to claims 20 and 21, Bessler discloses the claimed invention except for specifically disclosing that said body of compressible material has a thickness in the range of 0.5 inch to 12.0 inches, or in the range of 1 inch to 4 inches. However, Bessler does disclose that the sheet 66 is approximately 1/8 of an inch thick. Therefore, according to the drawings it appears that the compressible material is at least 8 times thicker than the sheet 66. Thus, it appears that the compressible material has a thickness within the applicant's claimed range. On the other hand, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the compressible material of a thickness within the claimed range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. By making the compressible material 1 or 2 inches thick, it will fit on a typical window sill without hanging over the edges of the sill.

Allowable Subject Matter

5. Claims 7, 17-19, and 29-43 are allowed.
6. Claims 9-15 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations

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of the base claim and any intervening claims. The examiner would also like to point out that claim 16 would be allowable if rewritten as claiming the combination.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 4-6, and 20-22 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031.

The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.
January 8, 2004


BRIAN E. GLESSNER
PATENT EXAMINER